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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,885	04/15/2004	Dan Prescott	DPRI-H71	7299
7590		10/12/2007	EXAMINER	
Karl M. Steins		SMALLEY, JAMES N		
Steins & Associates		ART UNIT		
Suite 120		PAPER NUMBER		
2333 Camino del Rio South		3781		
San Diego, CA 92108		MAIL DATE		
		DELIVERY MODE		
		10/12/2007		
		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/824,885

Applicant(s)

PRESCOTT, DAN

Examiner

James N. Smalley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Clarke US 6,644,490.

Clarke '490 teaches an elongate body defined by an upper head, lower head, front and rear faces and opposing side faces therebetween, whereby the faces are separated by a greater distance adjacent the head than the tip, and an attachment member.

Regarding claim 2, Examiner notes the phrase "in contour" is defined by the Random House Unabridged Dictionary, enclosed herewith, as "the outline of a figure or body; the edge or line that defines for bounds a shape or object." Thus, referring to Clarke '490 figure 1, it can be seen that the elongate body/plug element is rounded on the sides at (11) but are planar in contour because they have smooth flat edges in profile.

Regarding claim 3, as noted above the plug has rounded edges.

3. Claims 8-12 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Long US 5,154,327.

Long '327 teaches a plug (18), an insulating sleeve (14, 14A), a lanyard (19) interconnecting the plug and sleeve, a plug pocket (19C) associated with the sleeve, whereby the sleeve defines a cup chamber having an open top and bottom, capable of being used on a cup, whereby the pocket is attached

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to the outer layer of the sleeve and attachment means comprising the integral connection (19A, 19B) for attaching the lanyard to the sleeve and plug.

Regarding claim 20, Examiner notes the claim is only drawn to an accessory for beverage containers per the preamble of claim 17, and therefore it must only be capable of being used in the intended manner, i.e. it must only be capable of use with beverage containers. Because Long' 327 anticipates all claimed structure of claims 17-20, it is inherently capable of being used for beverage containers including those with generally rectangular apertures. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke US 6,644,490 in view of Lukacevic US 6,296,141.

This rejection is an alternative to the rejection of claim 2 under 102(e) above, should Applicant disagree that the faces of the plug/elongage body of Clarke '490 are not generally planar in contour.

Lukacevic '141 teaches a drinking cup lid with a rectangular opening having slightly rounded edges.

It would have been obvious to one having ordinary skill in the art at the time the invention to modify the shape of the opening of Clarke '490, forming it to a rectangular opening which furthermore would require reshaping the elongated body/plug to a corresponding shape which would thus have generally planar faces meeting at rounded edges, as taught to be known by Lukacevic '141, motivated by the benefit of material reduction from forming the curved sides of the plug into flat faces. Furthermore,

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Examiner notes a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke US 6,644,490. Clarke '490 fails to teach a face having indicia thereon.

Examiner notes it has been held that printed matter is given patentable weight only when a functional relationship exists between the printed matter and the substrate or element to which it is attached. See MPEP 2112.01(III). In the instant invention, it does not appear that the indicia has a functional relationship. See attached form "11. Printed Matter" which defines what comprises a functional relationship.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the elongate body/plug of Clarke '490 with indicia, motivated by the benefit of communicating a visual message, such as an advertisement or instruction, to a user.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke US 6,644,490 as above in claim 4, in view of Graves US 3,953,932.

Clarke '490 fails to teach engraving.

Graves '932 teaches engraving indicia (25) on a plastic chip by engraving (column 4, lines 15-22).

It would have been obvious to provide indicia on the elongate body/plug of Clarke '490 by engraving, as taught to be known by Graves '932, motivated by the benefit of making the indicia permanent and easy to read.

Furthermore, Examiner notes the claim is drawn to a process limitation within the scope of an apparatus claim. In such cases, the claim is only given patentable weight to the degree that it materially affects the final product. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-

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process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke US 6,644,490 as above in claim 6, in view of Bostelman US 5,295,601.

Clarke '490 fails to teach the body comprising a billet of metal material.

Bostelman '601 teaches in column 3, lines 45-48 that is desirable to form plugs of metal material in order to "give [them] substantial strength and durability."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the plug of Clarke '490, forming it of metal, as taught to be known by Bostelman '601, motivated by the benefit of giving it substantial strength and durability. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Long US 5,154,327 in view of Donkin US 152,980.

Long '327 fails to teach the lanyard being formed of a chain of interconnected links.

Donkin '980 teaches a stopper for an oil can which is connected to a retaining ring (E) by a chain (D) of interconnected chain links.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lanyard of Long '327, forming it of a chain of interconnected links as taught to be known by Donkin '980, motivated by the benefit of providing a more-flexible retaining link.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise

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extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/090,584. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

11. Claims 14-16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jns

 6.22.2007

  
ANTHONY D. STASHICK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700